

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

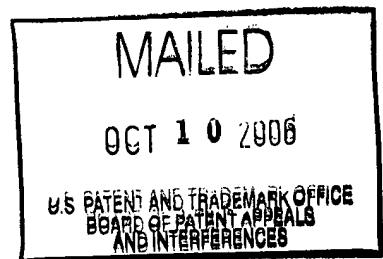
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY E. MARTINEZ and MICHAEL D. RAHN

Appeal No. 2006-2923
Application No. 09/981,905

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-17, which constitute all the claims pending in this application.

The disclosed invention pertains to a method of visually indicating data transfer responsive to a pointing device data transfer command (e.g., cut, copy, paste, etc.). Specifically, a display position indicator is modified and data transfer is animated. In one embodiment, the animation includes reducing a marked object and moving the reduced object through the display position indicator into an indicator bubble.

rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Johnson fully meets the invention as set forth in claims 1-4 and 6-17. We reach the opposite conclusion, however, with respect to claim 5. Accordingly, we affirm-in-part.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Johnson [answer, pages 3-7]. Regarding independent claims 1, 9, and 17, appellants argue that Johnson does not modify a display position indicator on a display screen as claimed [brief, page 9; reply brief, page 2]. According to appellants, Johnson's snapping text

to a cursor does not meet this limitation because a display position indicator as claimed indicates the completion level of a current data transfer [id.]. Appellants emphasize that Johnson merely visualizes moving text, but the invention visualizes the completion level of a task by modifying the display position indicator [id.].

The examiner responds that the broadest reasonable interpretation of the limitation does not preclude Johnson's teaching of adding a text object to the cursor [answer, page 9]. The examiner notes that once the text object is snapped to the cursor, the object will follow the cursor's movement. Therefore, the text object itself becomes a display position indicator [id.].

We will sustain the examiner's rejection of independent claims 1, 9, and 17. We agree with the examiner that Johnson's snapping of the text object to the cursor essentially modifies the display position indicator on a display screen as claimed. In Johnson, after the user selects text, a text object is created that resembles the selected text. When the cursor moves, the text object is snapped to the cursor and follows the cursor on the display without obscuring the insertion point [Johnson, col. 1, lines 42-48; col. 2, lines 60-69; col. 4, line 66 - col. 5, line 10].

Johnson's cursor is a "display position indicator" giving the term its broadest reasonable interpretation. When the text

object is snapped to the cursor in Johnson, the cursor and text object unite to produce a modified display position indicator that the user can position on the display as desired. In our view, the modified display position indicator resulting from the union of cursor and text object fully meets modifying a display position indicator on a display screen as claimed. Appellants' argument that the display position indicator must indicate the completion level of a data transfer is unavailing. Nothing in the independent claims requires indicating the completion level of a data transfer. In short, appellants' arguments are not commensurate with the scope of the claims.

The examiner's rejection of independent claims 1, 9, and 17 is therefore affirmed. Since appellants have not separately argued the patentability of dependent claims 2, 3, 6, and 10-16, these claims fall with independent claims 1 and 9. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(vii).

Regarding claim 4, appellants argue that Johnson does not disclose reducing a marked object to a reduced object as claimed. Appellants contend that, at most, Johnson discloses limiting the size of the text object [brief, page 10; reply brief, page 5]. The examiner responds that the broadest reasonable interpretation of the limitation does not preclude Johnson's limiting the size of the text object [answer, pages 11 and 12].

We will sustain the examiner's rejection of claim 4. We first note that the limitation calling for a "marked object" reads on the selected text 30 that is indicated by reverse video [see Johnson, col. 3, lines 28-31; Fig. 3A]. Text object 34 is created from the selected text (i.e., the "marked object") [id., col. 4, lines 20-21; Fig. 3C]. Significantly, the text object merely represents the selected text visually and may not include all of the selected text [id., col. 4, lines 21-23]. Furthermore, the text object may be a reduced-size bit map of the selected text or even a dotted outline of the selected text [id., col. 27-31]. All of these forms of text objects essentially depict the selected text in a reduced format (i.e., abbreviating the text, reducing the image size, or outlining the text). In view of the text object's depiction of a reduced form of the selected text, the text object fully meets a "reduced object" as claimed. Moreover, appellants have not rebutted the examiner's prima facie findings that the text object of Johnson is moved through the display position indicator as claimed by its gradual movement to the lower portion of cursor 20 [see id., col. 5, lines 3-5 and 45-53]. The examiner's rejection of claim 4 is therefore sustained.

Regarding claim 5, the examiner indicates that the selected text is gradually moved to the other end of the cursor where size may be modified [answer, pages 4 and 5]. Appellants argue that Johnson does not disclose moving the object while the object is

being reduced as claimed, but rather modifying the text's size after movement [brief, page 11; reply brief, page 5]. The examiner responds that Johnson zooms an object from a source location to a destination location [answer, page 12].

We will not sustain the examiner's rejection of claim 5. The examiner has simply not shown - nor can we find - anything from Johnson's disclosure that teaches moving the marked object towards the display position indicator while the object is being reduced. Simply put, the object's movement and reduction must occur simultaneously. Johnson, however, reduces the object prior to moving it. That is, the text object is created -- and the concomitant reduction of the marked object that occurs as a result of such text object creation¹ -- before the text object is moved (snapped to the cursor) [see Johnson, col. 1, lines 42-48; col. 2, lines 63-69; Fig. 2 (note steps 62 and 72)]. The examiner's reference to zooming in Johnson adds nothing to establishing when reduction occurs. The examiner's rejection of claim 5 is therefore reversed.

Regarding claim 7, appellants argue that Johnson does not disclose expanding a reduced object as claimed [brief, page 11]. Although the examiner responds by repeating the arguments made in connection with claim 5 [see answer, page 12], appellants did not address the examiner's position, but merely repeated the allegation that Johnson does not disclose expanding a reduced

¹ See pages 5 and 6, supra, of this opinion.

object [reply brief, page 5]. Significantly, appellants' allegation lacks supporting analysis and essentially ignores the examiner's position articulated in the answer. Such unsupported conclusory statements hardly suffice to persuasively rebut the examiner's prima facie case of anticipation.

The rejection of claim 7 is therefore sustained. Since appellants have not separately argued the patentability of dependent claim 8, it falls with claim 7. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(vii).

In summary, we have sustained the examiner's anticipation rejection with respect to claims 1-4 and 6-17. However, we have not sustained the examiner's rejection of claim 5. Therefore, the decision of the examiner rejecting claims 1-17 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP
Administrative Patent Judge

Jean R. Homere

JEAN R. HOMERE
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

JS/gw

Appeal No. 2006-2923
Application No. 09/981,905

CARDINAL LAW GROUP
SUITE 2000
1603 ORRINGTON AVENUE
EVANSTON IL 60201

INDEX OF BOARD OF PATENT APPEALS
AND INTERFERENCES

APPLICANT'S NAME

DECISION DATE

DECISION

☐ R ☐ M ☐ A☐ CLAIMS ALLOWED BY EXAMINER

REJECTION

100		Non- statutory subject matter
101		Utility, operativeness
101a		Double patenting
102		Anticipation
103		Obviousness
103a		Evidence respecting obviousness (unexpected results, commercial success affidavits, ect.)
103b		Analagous or non-analagous art
103c		Propriety of combining references
103d		Specific deviation from prior art (new use of old material, difference in range, change in size or proportion, etc.)
112		Sufficiency of disclosure
112a		Undue breadth of claims
112b		Definiteness of claims
112c		New matter
251		Reissue
300		Res judicata
301		Uninformative decision
302		Miscellaneous
SUBJECT MATTER		
171		Designs
161		Plants

REFERENCES

102a		Prior use or Publication
102b		Statutory bar
102c		Abandonment
102d		Patenting outside convention
102e		Copending prior application
102f		Derivation of invention
102g		Priority in another
119		Foreign filing benefit
120		Prior U.S. filing benefit
304		Judicial notice
ANCILLARY AND PROCEDURAL		
193a		Dismissal
193b		Remand
196b		New ground of rejection
196c		Recommendation
197b		Reconsideration
195		Affidavits, Admissibility
131		Antedating affidavits